APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,023	01/10/2002	Toshihiro Morita	450101-02844	4611

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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *14 September 2004*.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *41-66* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *41-66* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

Claim Status

Claim 41-66 are pending for examination, none of the claims have been

amended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41, 43, 48, 50, 53, 55, 57, 60, 62 and 64, are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,412,012 issued to Bieganski et

al. (hereinafter referred as '012 Bieganski).

Claims 41 and 48:

Bieganski discloses a digital data recommendation system [e.g., Fig. 1]

comprising:

- means for recording usage history data and the related data

recorded in the recording means based on the filtering data [e.g.,

the CPU (102, Fig. 1) can coupled to the memory system (104,

Fig. 1) and the secondary storage(108 of Fig. 1) to log history data

indicative of usage history of the group of contents. For example,

the data being stored in the History Set (203), Fig. 2; or the

customer's behavior data recorded at a shopping set being

specified at col. 8, lines 7-8; or the Purchased Items associated to

a particular user's Transaction or the total number of Transaction

being purchased of the unit 900, Fig(s). 9; the Recommendation

engine (600, Fig. 14; col. 14, lines 31-33)];

- means for computing per each of the contents a weight related to

a number of checkout from the history data and the related data

recorded in the recording means based on the filtering data [e.g.,

the compatibility modifier (200, Fig. 2) can accept a stored number

of checkout (or the number of times each item was purchased,

Fig. 9) per each of the contents from the history data on a filtering

rule specified by a marketer or customer or the processing of

recommendation engine itself (col. 9, lines 63-49) to compute a

weight related to the number of checkout (the steps 752-756, Fig.

7A)];

- means for selecting a content from a group of contents based on

weight computed by the computing means [e.g., the user interface

adapter coupled to the Input Device (114, 118, Fig 1) can be used

to select the modified recommendation set based on weight

computed by the compatibility modifier (Fig. 5; Fig. 6; col. 13, line

21 - col. 14, line 14; col. 14, line 31-col. 15, line 2)];

- means for display a list of at least titles in the information related

to the contents selected by the selecting means [e.g., the Display

Adapter (112, Fig. 1) coupled to the Display Device (116, Fig. 1)

can display a list of recommended books selected by the book

reviewer (col. 7, lines 49-54)].

As to claims 53, 55, 60 and 62:

these claims recite the same features as claims 41 and 48, in form of

computer method / program storage medium, hence are rejected for the same

reason.

As to claims 43 and 50:

Bieganski discloses all the features as claimed by applicant in claims 41

and 48. He further teaches the system having means [e.g., the User Input device

(118), Fig. 1] to add new filtering data [e. g., the complement items in the

shopping set, or the complement items in the historical and original

recommendation set are added to the recommendation process at the modules:

452-456, Fig. 4A; col. 11, lines 14-32; lines 40-56].

As to claims 57, and 64:

these claims contain the same features as their base claim and recite the

same features as claims 43 and 50, in form of computer method / program

storage medium, hence are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

1.   Claims 42, 44-47, 49, 51-52, 54, 56, 58-59, 61, 63, 65-66, are rejected under 35

U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,412,012 issued to

Bieganski et al. (hereinafter referred as Bieganski) in view of U.S. Patent No. 6,662,231

issued to Drosset et al. (hereinafter referred as Drosset).

As to claim 42:

Bieganski discloses all the features as claimed by applicant in claim 41.

Bieganski further discloses means for computing a weight related to an

item per each of the contents from the related data based on the filtering data.

Furthermore, he teaches that observing a customer's shopping behavior to

create a shopping set as filtering input to the compatibility modifier for guiding the

modifier to apply the shopping set data as filtering criteria for computing a weight

to the data item based on a particular application [e.g., col. 9, lines 63 – col. 10, line 43]. In addition, he cited his compatibility–aware system can enhance the internet audio entertainment service system with benefit of compatibility modified recommendations [col. 19, lines 55 –col. 20, line 7].

Bieganski did not expressly cite to compute a weight for a period for which the content has been checked out.

However, Drosset discloses a system providing audio service over a communication network [Drosset: Title] therein, the system measures duration for which the content has been checked out [e.g., the play-out time of Fig. 4; the step (404, Fig. 10); the step (430, Fig. 11); col. 8, line 10 – line 36].

Thus, considering the combination of Bieganski and Drosset, it would have been obvious to one of the ordinary skill person in the art at the time the invention was made to further modify the combined system of Bieganski and Drosset by computing a weight for a period for which the content has been checked out.

The ordinary skilled artisan would have been motivated to modify the combination of Bieganski and Drosset per computing a weight of a period for which the content has been checked out for the following purposes: 1) facilitating the combined system to track the cost of certain play-out time for the content has been check-out from an audio entertainment service system [e.g., Drosset: Abstract, lines 7-10]; 2) using the computed weight for the duration of play-out time as a filtering rule to enhance the recommendations of the audio

entertainment service system [e.g., Bieganski: Abstract, lines 5-11; col. 19, lines

55-7].

As to claim 44:

Bieganski discloses the features claimed by applicant as following:

- means [e.g., Bieganski: Fig. 1; col. 1, lines 35-40; the

    Recommendation engine (600), Fig. 14, col. 14, lines 31-33] for

    recoding related about the group of contents [e.g., Bieganski: the

    Purchased Items of a Transaction & total number of Transaction

    being purchased (900), Fig(s). 9] and filtering data intended for

    computation of a weight per each of the contents [e.g., Bieganski:

    the item compatibility rules (204), Fig. 2, col. 7, lines 21-24];

- means for computing a weight based on the filtering data [e.g., the

    compatibility rule specified by a marketer or customer or the

    processing of recommendation engine itself (col. 9, lines 63-49)

    can be input to the compatibility modifier (200, Fig. 2) to compute

    a weight per each item of contexts; the steps: 752-756, Fig. 7A];

- means [e.g., Bieganski: the user Interface Adapter (114) or the

    user Input Device (118), Fig 1] for selecting a content from a

    group of contents [e.g., Bieganski: the recommendation set, col.

    10, line 66] based on weight (or strength or ranking or score) [e.g.

    Bieganski: col. 2, line 66 - col. 3, line 7] computed by the

computing means [e.g., Bieganski: the Compatibility-Aware Recommendation Engine (600, Fig. 6); col. 10, lines 14 -, lines 31-33, lines 38-49; Fig(s). 7A-B];

- means [e.g., Bieganski: the Display Adapter (112), the display (116), Fig. 1] for display a list of at least titles in the information related to the contents selected by the selecting means [e.g., Bieganski: the displayed list of recommended books selected by the book reviewer via the user input Device (118, Fig. 1), col. 7, lines 49-54].

Bieganski did not specifically disclose computing a weight related to playing time.

However, Drosset discloses computing a playing time per each of the contents from the related data [e.g., Drosset: the step (404), Fig. 10; the step(434), Fig. 11; Fig. 4].

Thus, considering the combination of Bieganski and Drosset, it would have been obvious to one of the ordinary skill person in the art at the time the invention was made to further modify the combined system of Bieganski and Drosset by computing a weight for a period for which the content being played.

The ordinary skilled artisan would have been motivated to modify the combination of Bieganski and Drosset per computing a weight of a period for which the content being played for the following purposes: 1)

facilitating the combined system to track the cost of certain elasped time

for the content has been played from an audio entertainment service

system [e.g., Drosset: Abstract, lines 7-10]; 2) using the computed weight

for the duration of play-out time as a filtering rule to produce a

compatibility-aware recommendation output set for the audio

entertainment service system [e.g., Bieganski: Abstract, lines 5-11; col.

19, lines 55-7].

As to claim 45:

The combined system of Bieganski and Drosset discloses all the features

as claimed by applicant in claim 44. Bieganski further disclose computing a

weight related to the genre of the content [e.g., Bieganski: the priority ranking

processing at col. 10, lines 6-17].

As to claim 46:

The combined system of Bieganski and Drosset discloses all the features

as claimed by applicant in claim 44, Bieganski further discloses computing a

weight related to the character included in the name of the content [e.g.,

Bieganski: col. 18. line 64 – col. 19, line 3].

As to claim 47:

The combined system of Bieganski and Drosset discloses all the features as claimed by applicant in claim 44, Bieganski further discloses the system having means [e.g., the User Input device (118), Fig. 1] to add new filtering data [e. g., the complement items in the shopping set, or the complement items in the historical and original recommendation set are added to the recommendation process at the modules: 452-456, Fig. 4A; col. 11, lines 14-32; lines 40-56].

As to claim 49:

This claim draws to the same features cited in the claims: 42 and 48, hence is rejected for the same reason.

As to claims 52, 54, 56, 59, 61, 63 and 66:

These claims contain the same features as in their base claims 48, 53, 55, 60 and 62 respectively. They further recite the same feature of claim 42 except in form of computer method / program storage medium, hence are rejected for the same reason

As to claims 51, 58, and 65:

These claims contain the same features as in their base claims 48, 55 and 62 respectively. They further recite the same features as claim 45 except in form of computer method / program storage medium, hence is rejected for the same reason.

Response to Arguments

Applicant's arguments filed on 9/14/2004 have been fully considered but they are

not persuasive.

The examiner disagrees with applicant's arguments that:

1) The present invention generates a list of content (i.e., a filtering package)

based on weights derived from both a user's history (i.e., usage history data) and a set

of filter parameters (i.e., filtering data)... Bieganski uses history data to generate the

filter which is then used to generate the weights. Hence, Bieganski does not use both

filter data and history data to generate the weights as required in the present invention.

2) The present invention imposes limits on the number of songs (or copies of a

song) that can be checked out at a time, Once this limit is reached, no additional songs

can be checked out until previously checked out songs are checked back in. Bieganski

simply does not disclose a "checkout" as meant in the present invention.

In response to applicant's arguments, that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., The present invention generates a filtering package based on weights derived from

both a user's history and a set of filter parameters. Furthermore, The present invention

imposes limits on the number of songs that can be checked out at a time, once this limit

is reached, no additional songs can be checked out until previously checked out songs

are checked back in) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to the rest of the arguments, applicant rehash issues already addressed on

record, hence the examiner maintains the same types of rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Susan Y Chen whose telephone number is 571-272-

4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

January 16, 2005

UYEN LE
PRIMARY EXAMINER